

### REMARKS

Claims 17-24, 27-28 and 30-39 are pending in the present application. Applicants respectfully request reconsideration of the present claims in view of the following remarks.

#### I. Prior Art Rejections:

##### Rejection of Previously Presented Claims 17-18, 21, 23-24, 35-37 and 39 Under 35 U.S.C. §102(b) In View Of PCT Publication No. WO91/10562 (Ochi)

Previously presented claims 17-18, 21, 23-24, 35-37 and 39 are rejected under 35 U.S.C. §102(b) as being anticipated by International Patent Publication No. WO91/10562 to Ochi et al. (hereinafter, "Ochi"). This rejection is respectfully traversed.

The disclosure of Ochi cannot anticipate Applicants' claimed invention as embodied in claims 17-18, 21, 23-24, 35-37 and 39 for at least the reasons given in Applicants' October 11, 2005 Amendment and Response. Accordingly, Applicants respectfully request withdrawal of this rejection.

In the Argument section of the January 25, 2006 Office Action (beginning on page 4, paragraph 13, line 1), Examiner Bissett states:

In response to the applicant's arguments that the claims are not anticipated, the examiner has explained that the dispersion limitations are interpreted as product-by-process limitations. It is the examiner's position that the resulting polyurethane layer would be the same regardless of the coating process. The declaration attempts to show the difference in polyurethane layers formed from different methods. However, the polyurethanes used in the examples appear to be different. One of skill in the art would expect different polyurethanes to have different properties. The applicant has not shown that the dispersion method itself serves to provide a different product.

Applicants disagree.

First, as discussed in Applicants' October 11, 2005 Amendment and Response, in order for Ochi to anticipate Applicants' claimed invention, Ochi must disclose each and every claim feature. *See, Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See also, Finnigan Corp. v. International Trade Commission*, 180 F.3d 1354, 1365, 51 USPQ2d

1001, 1009 (Fed. Cir. 1999) in which the Court states “In order to establish anticipation, a prior art reference must disclose every feature of the claimed invention.”

It is respectfully submitted that the only inquiry that needs to be address in the present anticipatory rejection is whether Ochi discloses all of the claim features in Applicants’ claimed invention. As discussed above, Ochi fails to disclose an article comprising a polyurethane substrate derived from an aqueous urethane dispersion, and therefore, cannot anticipate claims 17-18, 21, 23-24 and 35-36.

Examiner Bissett appears to take the position that product-by-process type claim features may be ignored in an anticipatory rejection. Applicants disagree, noting that MPEP §2113 clearly discusses that product-by-process claim feature must be considered if the product-by-process claim features impart distinctive structural characteristics to the final product. As stated in MPEP §2113, “The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding “interbonded by interfusion” to limit structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations.)”

Applicants respectfully submit that “a polyurethane substrate derived from an aqueous urethane dispersion” is the only way to describe the claimed polyurethane substrate, and as shown in the previously submitted Declaration of Dr. Falaas, the process step of forming an aqueous urethane dispersion of a polyurethane results in a polyurethane substrate having distinctive structural characteristics due to the process step. See, the previously submitted December 21, 2001 Declaration of Dr. Falaas.

Regarding the distinctive structural characteristics of polyurethane substrates derived from an aqueous urethane dispersion and the difference between (1) polyurethane substrates derived from an aqueous urethane dispersion and (2) polyurethane substrates derived from a solvent-based solution, the previously submitted

Declaration of Dr. Falaas clearly states that polyurethane substrates derived from an aqueous urethane dispersion have a much higher elongation and tear strength properties when compared to polyurethane substrates derived from a solvent-based solution. See paragraphs (7), (8) and (10) of the Declaration. Contrary to Examiner Bissett's understanding of these paragraphs, these statements by Dr. Falaas are not limited to the specific polyurethane compositions shown in paragraphs (5) and (6) of the Declaration, but apply generally to all polyurethane substrates derived from an aqueous urethane dispersion versus all polyurethane substrates derived from a solvent-based solution. The only paragraph of the Declaration specifically directed to properties of the polyurethane compositions shown in paragraphs (5) and (6) of the Declaration is paragraph (9), which indicates that the specific solvent-based polyurethane substrate having the formula as shown in paragraph (6) has an elongation of less than 5% when measured at 25°C.

Clearly, the Declaration of Dr. Falaas describes the distinctive structural characteristics of polyurethane substrates derived from an aqueous urethane dispersion and the differences in physical properties of (1) polyurethane substrates derived from an aqueous urethane dispersion as recited in independent claims 17 and 35 and (2) polyurethane substrates derived from a solvent-based solution.

Rejection of Previously Presented Claims 19-20 and 22 Under 35 U.S.C. §103(a)  
In View Of Ochi In Combination With Dunning

Previously presented claims 19-20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with U.S. Patent No. 4,101,698 issued to Dunning et al. (hereinafter, "Dunning"). This rejection is respectfully traversed.

Applicants respectfully submit that Examiner Bissett has failed to make a *prima facie* case of obviousness for at least the reasons given in Applicants' October 11, 2005 Amendment and Response. Applicants respectfully submit that there is no suggestion or motivation in the art of record for the proposed combination of the teaching of Ochi and the teaching of Dunning, and therefore the proposed combination fails to make obvious Applicants' claimed invention as embodied in claims 19-20 and 22 for at

least the reasons given in Applicants' October 11, 2005 Amendment and Response. Accordingly, Applicants respectfully request withdrawal of this rejection.

In the Argument section of the January 25, 2006 Office Action (on page 5, paragraph 14), Examiner Bissett states:

Regarding the arguments concerning the 103 rejections, the examiner has provided motivation from the prior art that the substitution of metals would provide equally reflective and processible layers. One of skill in the art would recognize the equivalence of the layers and so would not need to experiment to realize the benefits of the metal layer substitution.

Applicants disagree.

As discussed in Applicants' October 11, 2005 Amendment and Response, there is no suggestion in the teaching of Ochi or the teaching of Dunning of the desirability to substitute indium or tin for the metals disclosed in the teaching of Ochi. Further, there is no suggestion in either the teaching of Ochi or the teaching of Dunning of the "equivalence" of the various metal layers. For example, the teaching of Dunning clearly discloses that chromium is the preferred metal of choice. (See, for example, Dunning, column 2, line 6.) If one skilled in the art, given the teaching of Ochi, would have been motivated to seek out the teaching of Dunning and then modify the articles of Ochi as suggested by Examiner Bissett by substituting a metal of Dunning into the articles of Ochi, the teaching of Dunning would clearly suggest the use of chromium as the substituted metal, not indium or tin.

Further, as discussed in Applicants' October 11, 2005 Amendment and Response, Examiner Bissett has resorted to an "obvious-to-try" rejection, which has been deemed improper by the Court. *See, In re Tomlinson*, 363 F. 2d 928, 931, 150 USPQ 623, 626 (CCPA 1966).

Rejection of Previously Presented Claims 27-28, 30-31 and 38 Under 35 U.S.C. §103(a) In View Of Dunning In Combination With Kunevicius

Previously presented claims 27-28, 30-31 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Dunning in combination with U.S. Patent No. 3,439,950 issued to Kunevicius (hereinafter, "Kunevicius"). This rejection is respectfully traversed.

The proposed combination of the teaching of Dunning and the teaching of Kunevicius fails to make obvious Applicants' claimed invention as embodied in claims 27-28, 30-31 and 38 for at least the reasons given in Applicants' October 11, 2005 Amendment and Response. Accordingly, Applicants respectfully request withdrawal of this rejection.

In the Argument section of the January 25, 2006 Office Action (on page 5, paragraph 15), Examiner Bissett states:

In response to the applicant's arguments that Kunevicius does not teach the claimed pressure sensitive adhesive foam tape, it is the examiner's position that the reference's teaching of a cellular cushion having a pressure-sensitive adhesive layer thereon constitutes a pressure sensitive adhesive foam tape. The reference teaches foam tape strips used to adhere a molding to an auto body (col. 5 lines 31-41). An article containing a body, a foam layer, and an adhesive is encompassed by the term "adhesive foam tape".

Applicants disagree.

Applicants respectfully submit that Examiner Bissett's claim interpretation of the term "pressure-sensitive adhesive foam tape" is incorrect. Applicants submit that one skilled in art would not consider the term "pressure-sensitive adhesive foam tape" to encompass a non-adhesive cellular structure having a pressure sensitive adhesive layer thereon. Further, it is clear from a review of Applicants' original specification that the term "pressure-sensitive adhesive foam tape" as used in Applicants' original specification refers to an adhesive foam tape formed from a pressure sensitive adhesive wherein the pressure sensitive adhesive has a cellular structure. See, for example, FIG. 2, which depicts acrylic pressure-sensitive adhesive foam tape 28, as well as Examples 1-11 and 17, which describe the use of an acrylic pressure-sensitive adhesive foam tape.

Rejection of Previously Presented Claims 27-28, 30-34 and 38 Under 35 U.S.C. §103(a) In View Of Ochi In Combination With Kunevicius

The proposed combination of the teaching of Ochi and the teaching of Kunevicius fails to make obvious Applicants' claimed invention as embodied in claims 28 and 30 for at least the reasons given in Applicants' October 11, 2005 Amendment and Response and for at least the reasons given above. Accordingly, Applicants respectfully

request withdrawal of this rejection.

II. Conclusion:

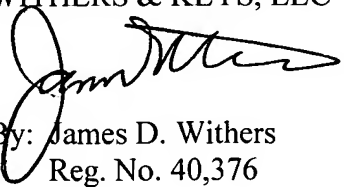
For at least the reasons given above, Applicants submit that claims 17-24, 27-28 and 30-39 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Bissett believe that anything further is necessary to place the application in better condition for allowance, Examiner Bissett is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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